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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,158	Applicant(s) SUTTON ET AL.
	Examiner JAGDISH N. PATEL	Art Unit 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 12/7/09.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/7/09 has been entered.

Response to Amendment

2. Claims 15, 26, and 27 have been amended per request. Note that the claims are analyzed under 35 USC § 101 in view of the machine-or-transformation test of patent eligibility. (See below).

Response to Arguments

Rejection under 35 U.S. C. § 112

3. Rejection of claims 15-17 and 19-27 under 35 U.S. C. § 112 have been withdrawn.

Rejection under 35 U.S. C. § 102/103

4. Rejection of claims 15-17 and 19-27 under 35 U.S. C. § 102(b) and U.S. C. § 103(a) are maintained as stated in prior office actions (reproduced below) since the arguments presented by the Applicant are not persuasive.

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The claims recite process steps of :

acquiring a purchase card from a purchase card provider,
providing purchase transactional information, including the account number associated with the purchase card,

and

performing a purchase transaction ..with the retailer based on the account number associated with the purchase card,

These are the manipulative steps of the claim(s).

Now let us examine what role, if any, the specific content of the purchase card plays in each of the aforementioned manipulative steps.

The act of acquiring is interpreted as obtaining the purchase card from the card provide, but, the specifics of the purchase card does not alter the acquiring step. In other words, it is performed regardless of the characteristics of the card.

The act of providing purchase transactional information, including the account number associated with the purchase card, likewise, does not depend, or alter the process of providing purchase transaction information. In other words, it is performed regardless of the characteristics of the card or whether the retailer is purchase card provider not.

Likewise, the act of performing purchase transaction by transacting purchase with the retailer based on the account number associated with the purchase card does not depend on the characteristics of the card.

Based on the foregoing analysis, it is evident that, the purchase card having a card holder name (whether different from the purchaser's name or not) is a non-functional descriptive matter

since it does not alter the process of acquiring, providing or (performing and) transacting steps of claim 15. Alternatively, the claimed process is performed independent of whether the cardholder name is same as the purchaser or different. (See following explanation for legal basis).

Since we are examining applications for utility patents, the claims must be directed to systems, methods or articles of manufacture that have a clear utility. See MPEP 706.03(a) for example. Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art.

Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Since the characteristic of the purchase card does not functionally interrelate to the claimed process step, the card holder name (whether different from the purchaser or not) does not constitute a limitation and therefore not considered for patentability.

As explained in the foregoing discussion, this limitation does not render the claim allowable over Risafi because the newly added limitation language is not functionally

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interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation.

Effect of the new amendment of claim 15 etc.

The newly added limitation, "the person who acquired the purchase card remaining anonymous during the purchase transaction because the cardholder name on the purchase card is not the card purchaser's name" describes the result which follows from the steps recited.

A "whereby" clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (CAFC 1993).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-17, 19-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a process to be statutory under 35 U.S.C. 101 it must (1) be tied to another statutory class (such as a particular apparatus or machine) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See recent decision by The U.S. Court of Appeals for the Federal Circuit decision in *Bilski* which Established Machine-Or-Transformation Test for statutory process. Prior to this in *Gottschalk v. Benson*, 409 U.S. 63, 71, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972), the Supreme Court reiterated the proposition that "a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing." The Court referred to the well established definition of "process" stated in *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L.Ed. 139 (1877). "A

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process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." Alternatively, "A process is a mode of treatment of certain materials to produce a given result. It is an act, a series of acts, performed upon the subject- matter to be transformed and reduced to a different state or thing." 308 F3d 1304 Schumer v. Laboratory Computer Systems Inc, 64 USPQ2d 1832, 1838 n 6 (Fed. Cir.2002).

In the instant case, none of the process steps of the method claims are tied to an apparatus such as a computer, nor do they transform a subject matter to a different state or thing. Accordingly, the claimed invention fails to qualify as a statutory process under the Guidelines.

Claim Rejections - 35 USC § 102

6. Claim 15-17, 19, 22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al (US Pat. 6473500) (hereafter Risafi).

As per claim 15 Risafi teaches a method of transacting a purchase which comprises acquiring a purchase card from a provider (see col. 3 L 53-60). Such card is a bearer instrument having an account number (Fig. 3a 306), but does not identify the person who acquired the card.

Risafi further teaches performing a purchase transaction by transacting a purchase with a retailer based on the account number associated the purchase card after purchase transactional information including the account number is provided to a retailer who is not the card provider (see Fig. 6a and relevant description of purchase at a merchant).

Risafi does not explicitly teach the specifics of the card holder name as stated in claim. However, as explained in detail *supra*, such specific characteristics of the purchase card does not

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play any role in the manipulative steps of the claimed processes. As such, under the doctrine of the printed matter (*In re Gulack and In re Ngai*) such limitations are deemed non-functional and do not warrant any treatment with respect to the prior art. (see also explanation provided below.)

As per claims 16 and 17 the purchase card has indicia of a card issuer (310 and 304). However, the purchase card does not have an indicia of an interchange association and indicia of other entity associated with distribution of the card. However, this data on the purchase card does not contribute the functionality of the claimed process and hence treated as non-functional descriptive material. Accordingly, no patentable weight is given to these non-functional descriptive. It has been ruled by the courts that non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983), *In re Ngai* 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)

The examiner also respectfully submits that this analysis is consistent with the USPTO policy as affirmed by the Board of Patent Appeals and Interferences (BPAI) (See *Ex Parte Herman Mathias*, Appeal No. 2005-1851 available at link <http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>)

which states that a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention cannot not lend patentability to an invention that would have been anticipated by prior art.

As per claim 19 Risafi teaches a step of acquiring a purchase card further comprises purchasing the purchase card from a retail establishment, where the purchase card is provided to the retail establishment by the purchase card provider. (col. 3 L 55 - col. 4 L 16).

As per claim 22, Risafi teaches a step activating the purchase card (see col. 3 L 61-65).

As per claim 25 Risafi teaches a step of transacting a purchase with the retailer by way of an authorization system of an interchange association (any authorization of card is carried out over a payment network. such step is therefore, inherent in Risafi, see Fig. 6a)

Claim Rejections - 35 USC § 103

7. Claims 20, 21, 23 and 24 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi as applied to claim 19 above, and further in view of Official Notice.

Various feature recited in claims 20-23 such as consignment arrangement and service fee charges are old and well known practices in commerce and the examiner takes official notice of these facts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these features in order to provide incentives to the card distributors so as to participate in the card distribution process. Providing contact information is also old and well known feature and is provided to facilitate communication with the card issuer regarding account balances etc.

All limitations of claims 26 and 27 have been fully analyzed in the foregoing analysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on Monday – Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KRAMER JAMES A can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693